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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/807,459

03/24/2004

Eric Benazzi

PET-2135

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EXAMINER

HAILEY, PATRICIA L

ART UNIT

PAPER NUMBER

1755

MAIL DATE

DELIVERY MODE

06/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/807,459	<b>Applicant(s)</b> BENAZZI ET AL.	
	<b>Examiner</b> Patricia L. Hailey	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 7-14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                   |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                              | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/24/04</u> . | 6) <input type="checkbox"/> Other: _____                                                |

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-6, in the reply filed on March 28, 2007, is acknowledged.

In addition to the aforementioned election, Applicants have filed an amendment, in which claims 15 and 16 have been added. Claim 15 depends from claim 1 and is therefore part of elected Group I. Claim 16 depends from non-elected claim 7, and is therefore also non-elected.

2. Claims 7-14 and 16 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected process of dewaxing, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 28, 2007.

Claims 1-6 and 16 are now under consideration by the Examiner.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**4. Claims 1-6 and 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/807,504.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because the respective sets of claims are directed to catalyst comprising at least one ZBM-30 molecular sieve zeolite synthesized with a structuring agent (e.g., triethylenetetramine), at least one hydro-dehydrogenating element, and at least one porous mineral matrix.

Although the claims in the instant application recite an additional component, both sets of claims recite the term "comprising" which opens the claims to additional, unspecified and non-deleterious components.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**6. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Benazzi et al. (WO 02/48289, Applicants' cited art\*, with U. S. Patent Application Publication No. 2004/0065585 applied as its English language equivalent).**

Benazzi et al. teach a catalyst comprising at least one molecular sieve such as ZBM-30 (paragraph [0085]). This reference also teaches additional molecular sieves such as NU-10, ZSM-22, Theta-1, ISI-1, and KZ-2 (paragraphs [0090] and [0092]).

The catalyst may also comprise a matrix. See paragraph [0094] of Benazzi et al.

Lastly, the catalyst also comprises hydro-dehydrogenating elements, such as platinum and palladium, and molybdenum and tungsten. See paragraph [0095] of Benazzi et al.

In view of these teachings, Benazzi et al. anticipate claims 1-5.

\*(Cited on Applicants' Information Disclosure Statement, filed March 24, 2004.)

**7. Claims 1-5 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent No. 0 065 400.**

The European Patent teaches a zeolite designated at NU-10, which is made from triethylenetetramine. See the Abstract, page 15, Example 3; page 16, Examples 4 and 6; page 21, Example 12; page 27, Examples 13 and 14.

NU-10 is used as a catalyst and may further contain hydrogenation-dehydrogenation metals such as platinum or palladium, as well as elements such as

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molybdenum and tungsten. See page 11, line 25 to page 12, line 27 of the European Patent. The catalyst may also contain an inorganic matrix such as alumina.

In view of these teachings, the European Patent anticipates claims 1-5 and 15.

### ***Priority***

8. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Document was filed on March 24, 2004.

### ***Conclusion***

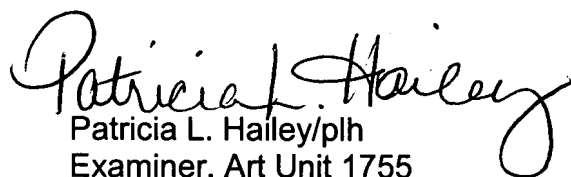
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays, from 7:00 a.m. to 3:30 p.m.

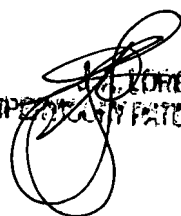
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Patricia L. Hailey/plh  
Examiner, Art Unit 1755  
June 11, 2007

  
J. LORENZO  
SUPERVISOR PATENT EXAMINER